represents a point of attachment. No new matter is believed to be introduced by the above amendment.

REMARKS

Claims 1-44 are pending. Favorable reconsideration is respectfully requested.

At the outset, Applicants thank Examiner Willis for helpful suggestions to overcome the rejections in the outstanding Office Action.

The rejection of Claims 1-44 under 35 U.S.C. § 103(a) over Walling et al in view of Jacobson et al is traversed below.

Walling et al describe a lipstick composition containing oils and waxes (see column 2, lines 13-14).

Jacobson et al describes a process for preparing nonionic surfactants (see Abstract).

In contrast, the claimed invention relates to a composition containing a volatile hydrocarbon-based solvent (e.g. isododecane), a non-volatile silicone compound which is soluble or dispersible in the volatile hydrocarbon-based solvent (e.g. phenyltrimethicone), and a non-volatile hydrocarbon-based oil which is soluble in the volatile solvent and incompatible with the non-volatile silicone compound and which satisfies the claimed Hanson solubility parameters (e.g. diglycerol diisostearate) (see Claim 1).

Walling et al fail to appreciate the benefits of the claimed composition that combines a volatile hydrocarbon-based solvent, a non-volatile silicone compound, and a non-volatile hydrocarbon-based oil. This is manifested by the fact that Walling et al fail to provide any examples having the claimed combination, and further manifested by the fact that Walling et al is absent of any disclosure or suggestion of diglycerol diisostearate.

Walling et al fail to provide, with sufficient specificity, any motivation to select the claimed **non-volatile** silicone oils from the laundry list of volatile and non-volatile

hydrocarbon oils and volatile and non-volatile silicone oils which spans more than two and one-half columns (see column 3, line 1 to column 5, line 40). Further, Walling et al lack *any* example of compositions containing **non-volatile** silicone oils.

More specifically, Walling et al disclose only six examples, each of which contains the DC 244 and DC 345 cyclomethicones as silicone compounds (see column 6, line 15 to column 7, line 44). DC 244 and DC 345 cyclomethicones are **volatile** silicone oils (see column 4, lines 18-31). **None** of the above-mentioned Examples contain **non-volatile** silicone oils.

In addition, as the Examiner correctly notes, Walling et al fail to disclose or suggest the use of diglycerol diisostearate as a non-volatile hydrocarbon-based oil altogether (see page 5, line 19, of the Office Action). That is, diglycerol diisostearate is neither disclosed nor suggested within the above-mentioned "laundry list" of oils.

In contrast, the claimed composition contains a **non-volatile** silicone compound which is soluble or dispersible in the volatile hydrocarbon-based solvent (e.g. phenyltrimethicone) and a non-volatile hydrocarbon-based oil (e.g. diglycerol diisostearate). In light of the above, it is clear that Walling et al fail appreciate the benefits of the claimed composition. Accordingly, Walling et al fail to provide sufficient specificity to motivate one to produce a composition containing a volatile hydrocarbon-based solvent, a non-volatile silicone compound, and a non-volatile hydrocarbon-based oil. Therefore, Walling et al fail to describe or suggest the claimed composition.

Jacobson et al fail to compensate for Walling et al's deficiencies. Jacobson et al describe a process for preparing nonionic surfactants (see Abstract). Citing column 4, lines 54-64, the Examiner asserts that Jacobson et al disclose that diglycerol di(fatty acid) esters have improved properties as compared to polyglycerol esters (see page 6, lines 5-8, of the Office Action). However, Applicants respectfully disagree with the Examiner's assertion

because Jacobson et al only disclose that diglycerol diisostearate obtained by their specific process has better properties than the a commercially available, i.e. less pure, polyglycerol diisostearate (see column 4, lines 54-64, and column 5, lines 17-20). Therefore, Jacobson et al does not describe or suggest that *any* diglycerol diisostearate has better properties than a polyglycerol diisostearate. To the contrary, Jacobson et al disclose that commercial products are insufficient to provide the improved properties of products which are of elevated purity and obtained by their specific process.

Further, Jacobson et al fail to disclose or suggest that diglycerol diisostearate, when obtained by their specific method, maintains its improved properties when combined with a volatile hydrocarbon-based solvent and a non-volatile silicone compound. Thus, no motivation to combine Jacobson et al and Walling et al exists: Why would Jacobson et al combine their compound having improved properties and risk losing those improved properties they had worked so hard to obtain? Accordingly, Walling et al in view of Jacobson et al fail to disclose or suggest the claimed composition.

Moreover, Applicants direct the Examiner's attention is to Examples 4-5 at page 19, line 9, to page 21, line 14, of the present specification, which describe the claimed composition containing a volatile hydrocarbon-based solvent, a non-volatile silicone compound, and a non-volatile hydrocarbon-based oil. A direct comparison of Example 4 with a the Comparative Example (Revlon "liquid lip") demonstrates that the claimed composition has improved properties over that of the Comparative Example which is a composition that does not contain the claimed combination of a volatile hydrocarbon-based solvent, a non-volatile silicone compound, and a non-volatile hydrocarbon-based oil. Accordingly, Applicants have demonstrated that the claimed composition (i.e. Example 4) containing the claimed combination is superior to compositions that do not. These data combined with the fact that Walling et al in view of Jacobson et al fail to provide sufficient

specificity to combine the claimed volatile hydrocarbon-based solvent, a non-volatile silicone compound, and a non-volatile hydrocarbon-based oil, provide ample evidence that the claimed composition is superior. Accordingly, Walling et al in view of Jacobson et al fail to disclose or suggest the claimed composition and withdrawal of this ground of rejection is respectfully requested.

The rejections of Claims 5 and 6 under 35 U.S.C. § 112, second paragraph, is believed to be obviated by the above amendment in combination with the following remarks.

As noted above, the chemical structure recited in Claims 5 and 6 has been amended in order to provide the customary three bonds to the nitrogen. Withdrawal of this ground of rejection is respectfully requested.

The Examiner contends that the phrase --at least one nonionic polar group selected from the group consisting of -COOH-- is "confusing and inconsistent." Applicants respectfully disagree on the grounds that the -COOH group does not contain a positive or negative charge. In other words, "-COOH" is nonionic as presently written in Claims 5-6. Accordingly, Applicants respectfully request that this ground of rejection be withdrawn.

Further, the Examiner contends that Claims 5-6 are additionally confusing because the elected species of hydrocarbon-based oil, e.g., diglycerol diisostearate, "does not appear to read on these claims because it contains -COOR groups rather than -COOH groups." Applicants respectfully traverse the rejection on the grounds that although diglycerol diisostearate does indeed contain -COOR groups, it also contains an -OH group, which is also recited in Claims 5-6 (see the above amended Claims 5-6). Accordingly, withdrawal of this ground of rejection is respectfully requested.

The requirement to amend the specification to include the material incorporated by reference is traversed below.

The Examiner apparently indicates the material disclosed at page 8, lines 9-12 and page 10, lines 14-17, "as essential material." Applicants respectfully disagree on the grounds that this material is non-essential. MPEP §608.01(p) states:

> "Essential material is defined as that which is necessary to (1) describe the claimed invention, (2) provide enabling disclosure of the claimed invention, or (3) describe the best mode . . . Nonessential subject matter is subject matter referred to for purposes of indicating the background of the invention or illustrating the state of the art."

Applicants respectfully submit that the subject matter disclosed at page 8, lines 9-12, and page 10, lines 14-17, is subject matter "illustrating the state of the art", and therefore may be incorporated by reference in accordance with MPEP §608.01(p). However, for the Examiner's convenience, Applicants have provided the references incorporated by reference at page 8, lines 9-12, and page 10, lines 14-17, so that the Examiner is provided with the relevant portions "illustrating the state of the art." Accordingly, withdrawal of this requirement is respectfully requested.

Applicants respectfully submit that the present application is now in condition for allowance. Favorable reconsideration is respectfully requested. Should anything further be required to place this application in condition for allowance, the Examiner is requested to contact Applicants' attorney by telephone.

Respectfully submitted,

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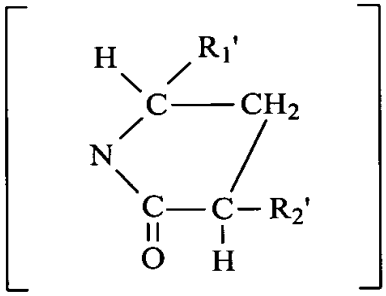
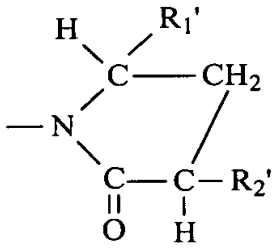
IN THE CLAIMS

--5. (Amended) The composition according to Claim 1, wherein said hydrocarbon-based oil has a chemical structure comprising at least one nonionic polar group selected from the group consisting of -COOH; -OH; $-PO_4$; -NHR with R representing H or a linear or branched C_1 to C_{20} alkyl or alkoxy group; $-NR_1R_2$ with R_1 and R_2 optionally forming a ring and each independently representing a linear or branched C_1 to C_{20} alkyl or alkoxy group or radical; and

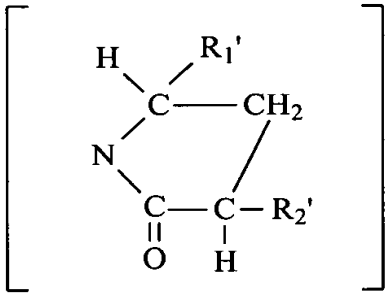


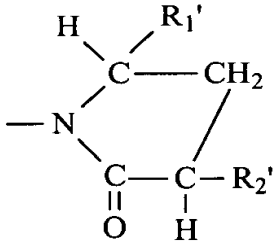


with R_1' and R_2' each independently representing H or a linear or branched C_1 to C_{20} alkyl

or alkoxy group; and combinations thereof.

6. (Amended) The composition according to Claim 1, wherein said hydrocarbon-based oil has a chemical structure comprising at least two nonionic polar groups selected from the group consisting of -COOH; -OH; $-PO_4$; and





with R_1' and R_2' each independently representing H or a linear or branched C_1 to C_{20} alkyl or alkoxy group; and combinations thereof.--